

### REMARKS

The claims are 1-14.

The claims were rejected as follows:

(A) Claims 1-5, 11 and 14 under 35 USC § 102 (lack of novelty) over Uhl et al. (US 5,219,969) (Uhl).

(B) Claims 1-14 under 35 USC § 103(a) (obviousness) over Tropsch et al (US 5,869,032) (Tropsch) in view of Kumar et al. (US 5,468,477) (Kumar).

(C) Claims 1-14 over Tropsch (ibid) in view of Kumar under the doctrine of obviousness type double patenting.

#### **(A) THE REJECTION UNDER 35 USC § 102**

For clarity, the claims have been recast in Jepson form, adding no new matter. The purpose of Jepson claim is to avoid unnecessary verbiage in describing what the skilled worker already knows. *See also In re Sutherland*, 146 USPQ 485, 489 (CCPA 1965) (The use of Jepson claims is "admirable"). The Jepson preamble is part and parcel of the claim itself and cannot be ignored.

This preamble as used by applicants gives "life, meaning and vitality" to the claims. *In re Cruciferous Sprout Litigation*, 64 USPQ2d 1202 (Fed.Cir. 2002). *See also In re Cruciferous Sprout Litigation*, 64 USPQ2d 1202 (Fed.Cir. 2002) ("all *factual* differences which may be properly noted in any portion of a claim must be included within the basis for comparison with prior art ...").

Thus, under the present facts, the preamble is not a "[F]uture intended use" as so regarded by the examiner. For this reason, alone, Uhl, which is not directed to such compositions, does not anticipate applicants' claims. As made clear in *Verdegaal Brothers, Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987), "A claim is anticipated only if each and every element of a claim as set forth in the claim is found either expressly or inherently described, in a single prior art reference. [Citations omitted.]"

Further, and of utmost significance, as previously discussed by applicants, Uhl does not disclose applicants' polymers. Applicants' invention according to generic claim 1, is directed to a skin composition or dermatological preparation comprising a copolymer obtained by polymerization of a monomer mixture comprising as component c) 0 to 40% by weight of at least one unsaturated acid or unsaturated anhydride. Uhl refers to crosslinked copolymers containing acrylic acid and/or methacrylic acid in an amount of from 50 to 99 parts by weight. As there is no overlap between the claimed range and the range disclosed by Uhl the claimed subject-matter is novel over Uhl et al.

It is further noted that claim 14 -- which, for clarity, has been made dependent on claim 1 -- uses the term "consists of" which clearly excludes any further monomers in the monomer mixture.

Accordingly Uhl does not anticipate, within the meaning of § 102.

**(B) THE REJECTION UNDER 35 USC § 103(A)**

It is the object of the present invention to provide new types of cosmetic compositions which permit improved skin care. In the examples on pages 26-27 of the

HOESSEL et al., Ser. No. 09/604,001

specification of the present application, a skin cream "A" according to the invention is compared with a skin cream "C" based on an uncrosslinked copolymer (according to Tropsh, U.S. 5,869,032). As can be taken from the table at the end of page 27, the feel on the skin of cream "A" was considered softer than the feel of cream "C". This demonstrates the improvement made by the present invention.

U.S. 5,869,032 (Tropsch et al.) discloses uncrosslinked copolymers of a quaternized N-vinylimidazole, N-vinylcaprolactam and N-vinylpyrrolidone.

U.S. 5,468,477 (Kumar et al.) discloses cosmetic compositions containing a vinylsilicone graft or block copolymer. Those polymers are structurally far remote from the polymers according to the present invention. They are prepared by free radical polymerization of a mercapto-functional silicone chain transfer agent and vinyl monomers (col. 4, lines 26-28). Different from a normal free-radically initiated copolymerization, here the vinyl monomers are grafted on the chain transfer agent (as depicted in col. 8, line 40) by reaction of the carbon-carbon double bond of the vinyl monomers with the mercapto groups (S-H-groups) of the chain transfer agent. The mercapto-functional silicone chain transfer agent does not have two ethylenically unsaturated double bonds. Therefore it is not a crosslinker that fulfills the definition of component (d) of the present application. Also, the vinyl monomers disclosed in the Kumar reference do not have two ethylenically unsaturated double bonds. Kumar does not disclose any component that fulfills the definition of component (d) of the present application.

Lacking from the combination of references is the necessary reason, teaching or

HOESSEL et al., Ser. No. 09/604,001

suggestion for modifying Tropsch in such a way as to come up with applicants' claimed invention without using impermissible hindsight. See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902,907, 5 USPQ2d 1788, 1792 (Fed Cir. 1988) (Improper to use applicants disclosure as "a guide through the maze of prior art references combining the right references in the right way so as to achieve the result of [applicant's claims]."

Accordingly the references do not make out the necessary case for obviousness within the meaning of 35 USC § 103(a). (See infra for discussion regarding the use of 37 CFR 1.132 declarations.)

**(C) THE REJECTION REGARDING DOUBLE PATENTING OF THE OBVIOUSNESS TYPE.**

This rejection is moot inasmuch as both Tropsch and Kumar, if applicable (which, it is submitted they are not as discussed above) are *statutory bars* under 35 USC § 102(b). Thus, if applicants overcome rejection (B), the instant rejection would be overcome for the same reasons. For essentially the same reason, it would do applicants no good to file the declaration suggested in the examiner's rejection (B).

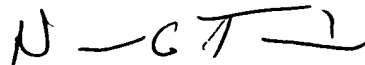
**(D) CONCLUSION**

Accordingly allowance is respectfully solicited. However, should the examiner disagree, it is requested that the amendment be entered to place this application in better condition for appeal, particularly as no new search would be involved.

HOESSEL et al., Ser. No. 09/604,001

Respectfully submitted,

KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'N - C T - 1'.

Norman G. Torchin  
Reg. No. 34,068

1350 Connecticut Ave., N.W.  
Washington, D. C. 20036

(202)659-0100